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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,420	12/07/1999	DEAN HILLER	11324/1	7662

7590 05/06/2004

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EXAMINER	
NGUYEN, CHAU T	
ART UNIT	**PAPER NUMBER**
2176	16

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/457,420	HILLER, DEAN	
	Examiner	Art Unit	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments (see Appellant's brief, page 6, lines 11-14), filed 01/24/2004, with respect to claim 1 have been fully considered and are persuasive. The finality of the previous Office action, mailed on 04/24/2004, has been withdrawn. Applicant's amendment submission filed on 02/07/2003 has been entered. Claims 1-17 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber et al (Farber), Patent No. 6,185,598, and further in view of Jerger et al. (Jerger), Patent No. 6,345,361.

4. As to claim 1, Farber discloses the invention as claimed, a method of processing an Internet site name comprising:

retrieving a regular expression stored at a Domain Name Server (col. 7, line 3 - col. 8, line 25, Fig. 2); and

performing a regular expression comparison between a first Internet site name and a character pattern at a Domain Name Server (col. 7, line 3 – col. 8, line 25, Fig. 2 and Fig. 3: the resource identifier (URL) for a given request is looked up in the rule base by matching it sequentially with each regular expression).

However, Farber does not disclose identify an Internet Protocol address for multiple similar site names. In the same field of endeavor, Jerger discloses wildcard characters may be used to specify multiple domain names (col. 17, lines 50-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Farber and Jerger to include identifying an Internet Protocol address for multiple similar site names. Jerger suggests using wildcard characters such as "*" or "?" for searching site names. Using these teachings combination with the DNS name resolving taught by Farber would result in the invention as broadly claimed by resolving regular expression into an IP address.

5. As to claim 2, Farber and Jerger (Farber-Jerger) disclose transmitting the first Internet site name from a first computer system to the Domain Name Server over the Internet (Farber, col. 6, line 40 – col. 7, line 26).

6. As to claim 3, Farber-Jerger disclose transmitting a responsive message to the first computer system if a match is found in the regular expression comparison (Farber, col. 6, line 40 – col. 8, line 18).

7. Claims 9-12 are corresponding apparatus and a set of instruction claims containing similar limitations as discussed in the method of claims 1-3; therefore, they are rejected under the same rationale.

8. Claims 4-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber and Jerger as applied to claims 1-3, and 9-12 above, and further in view of Schneider, Patent No. 6,338,082.

9. As to claim 4, Farber and Jerger disclose the limitations as described in claims 1-3. However, Farber and Jerger do not disclose the regular expression uses a Unix regular expression format. In the same field of endeavor, Schneider discloses DNS is implemented in a hierarchy of DNS servers (Unix machines running Berkeley Internet Name Domain (BIND) software) and an application-layer protocol that allows hosts and DNS servers to communicate in order to provide the translation service (col. 3, lines 4-38 and col. 9, lines 45-56). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of Unix regular expression as taught by Schneider into the system comparing between an Internet address name and characters at a DNS of Farber and Jerger, thereby resulting

in the claimed invention, since Schneider suggests that BIND is integrated into UNIX network programs for use in storing and retrieving host names and addresses.

10. As to claim 5, Farber-Jerger and Schneider (Farber-Jerger-Schneider) disclose the regular expression has a format ^\d{10}$.X.Y where ^\d{10}$ represents a string of ten numbers, X represents a sub-level domain and Y represents a top-level domain (Jerger, col. 17, lines 12-67: "*" character indicates zero or more characters and "?" indicates any single character, ".com" indicates top-level domain, ".microsoft.com" indicates sub-level domain or second level domain; Schneider, col. 3, line 66 – col. 4, line 12).

11. As to claim 6, Farber-Jerger-Schneider disclose the regular expression has a format ^[0-9]+$.X.Y where ^[0-9]+$ represents a string of numbers, X represents a sub-level domain and Y represents a top-level domain (Jerger, col. 17, lines 12-67: "*" character indicates zero or more characters and "?" indicates any single character, ".com" indicates top-level domain, ".microsoft.com" indicates sub-level domain or second level domain; Schneider, col. 3, line 66 – col. 4, line 12).

12. As to claim 7, Farber-Jerger-Schneider disclose the regular expression has a format ^\d{10}$.Z where ^\d{10}$ represents a string of ten numbers, and Z represents a geographically oriented top-level domain (Jerger, col. 17, lines 12-67: "*" character indicates zero or more characters and "?" indicates any single character, ".com"

indicates top-level domain, ".microsoft.com" indicates sub-level domain or second level domain; Schneider, col. 4, lines 13-30).

13. As to claim 8, Farber-Jerger-Schneider disclose the regular expression has a format ^[0-9]+$.Z where ^[0-9]+$ represents a string of numbers, and Z represents a geographically oriented top-level domain (Jerger, col. 17, lines 12-67: "*" character indicates zero or more characters and "?" indicates any single character, ".com" indicates top-level domain, ".microsoft.com" indicates sub-level domain or second level domain, Schneider, col. 4, lines 13-30).

14. Claims 13-17 are corresponding a set of instruction claims containing the similar limitations as the methods described in claims 4-8; therefore, they are rejected under the same rationale.

Response to Arguments

In the remarks, Applicant's argued in substance that

(A) In discussing the Farber and Schneider references, Applicant is making no admission that either reference has a filing date that predates the present invention.

As to point A, Applicant's present invention 09,457,420 was filed on 12/07/1999 and there is no priority dates for this application at all. The prior art includes Farber and Schneider references. The reference Farber was filed on Feb. 10, 1998, which predates the applicant's present invention. The reference Schneider was filed on March 15, 2000, but its provisional applications, No. 60/157,075 filed on Oct. 1, 1999, No. 60/130,136 filed on April 20, 1999, No. 60/160,125 filed on Oct. 18, 1999, and No. 60/125,531 filed on Mar. 22, 1999. and thus they all predates the applicant's present invention. Please see MPEP § 1893.03(b) for determining the effective filing date of an application.

(B) Neither Farber nor Schneider references teach or suggest the methods and apparatus recited in claims 1, 9, and 20.

As to point B, Farber teaches retrieving a regular expression stored at a Domain Name Server (col. 7, line 3 - col. 8, line 25, Fig. 2: a browser at a client receives a url, the browser extracts the host name from the url and uses a domain name server dns to

look up the network IP address of the corresponding server, the url for a given request is look up in the rule base by matching it sequentially with each regular expression); and

performing a regular expression comparison between a first Internet site name and a character pattern at a Domain Name Server (col. 7, line 3 – col. 8, line 25, Fig. 2 and Fig. 3: the resource identifier (URL) for a given request is looked up in the rule base by matching it sequentially with each regular expression).

However, Farber does not disclose identify an Internet Protocol address for multiple similar site names. In the same field of endeavor, Jerger discloses wildcard characters may be used to specify multiple domain names (col. 17, lines 50-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Farber and Jerger to include identifying an Internet Protocol address for multiple similar site names. Jerger suggests using wildcard characters such as "*" or "?" for searching site names. Using these teachings combination with the DNS name resolving taught by Farber would result in the invention as broadly claimed by resolving regular expression into an IP address.

(C) Farber and Schneider, taken singularly or in combination, fail to teach or suggest performing regular expression comparison with an Internet site name to identify an IP address for multiple similar site names.

As to point C, applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection as explained here

below, necessitated by Applicant's substantial amendment (i.e. performing regular expression comparison with an Internet site name to identify an IP address for multiple similar site names) to the claims which significantly affected the scope thereof.

15. Applicant's arguments and amendments filed on 02/07/2003 have been fully considered but they are not deemed fully persuasive. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., performing regular expression comparison with an Internet site name to identify an IP address for multiple similar site names) to the claims which significantly affected the scope thereof.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner can normally be reached on Monday-Friday from 8:00 am to 6:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (703) 305-9792.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 872-9306 (After Final Communications only)

(703) 872-9306 (Official Communications)

(703) 746-7240 (for Official Status Inquiries, Draft Communications only)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

Chau Nguyen
Patent Examiner
Art Unit 2176

SANJIV SHAH
PRIMARY EXAMINER